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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,784	07/31/2001	Jeffry J. Grainger	020313-000510US	4833
20350 7590 10/17/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER MOONEYHAM, JANICE A	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 10/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/919,784

Applicant(s)

GRAINGER ET AL.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,7-16,18-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3,7-16, 18-23, 25-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This is in response to applicant's communication filed on July 30, 2007, wherein:  
Claims 1, 3, 7-16, 18-23 and 25-30 are currently pending;  
No claims have been amended, added, or cancelled.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 9 recites the limitation "the first data source". There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 101***

The rejection of claims 29-30 under 35 U.S.C. 101 is hereby withdrawn.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 7-16, 18-23, 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette) in view of Petruzzi et al (US 6,049,811) (hereinafter referred to as Petruzzi) in view of Tran (US 2001/0049707).

Referring to Claims 1, 16, 18, 22-23 and 27:

Rivette discloses a computer implemented method, system and program, the system comprising a processor [285], a database in communication with the processor and computer readable medium (Figures 3 (316), Figures 4 and 5, Figure 6 (620) [0303] and Figure 8(808), Figures 111 and 117 and paragraphs [286] [289] [0290] and [0407]), the method comprising:

providing, at a client system, a search interface [0293] **to allow** a user to search one or more data sources for potential prior art references [0388-0444 Searching module][0393] [0396] [0407] [1209-1246] (Note that providing an interface to allow a user to search is not a positive recitation of a search being performed);

receiving, at the client system, input from a user indicating that the user has identified an electronic document as a prior art reference [313] [324] [0393-0394] [0396] [0407 if the user selects (by double clicking or other well known GUI operation such as selecting a patent and pressing a return button) (the Examiner interprets this as input from a user indicating that the user has identified an electronic document))] [795] [797] [1157];

in response to the input, transmitting a signal from the client system indicating that the user has identified a prior art reference [313] [324] [0393-0394] [0396] ]0407If the user selects (by double clicking or other well known GUI operation such as selecting a patent and pressing a return button] [795] [797] [1157] (The Examiner interprets the fact that the user can add any documents displayed in the Document pane to any group by using well-known drag-and-drop operations as an input that the user has identified

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an electronic document and the act of actually dragging and dropping as the user transmitting a signal);

receiving the signal at a sever system comprising a database [0373-0379] and [0392-0393 the documents identified by a search can be easily added to groups by invoking appropriate enterprise server commands] [0396] the client searching module enables displays search results and enables the user to manipulate and process the search results (such as by enabling the user to add the documents identified by a search to a new or existing group) [1247-1248 importing data];

in response to the signal, accessing the electronic document [0373-0379] (the document storage and retrieval module provide the customer with the ability to quickly, efficiently, and effectively access, display, and process any patent of interest);

loading into the database at least a portion of the document [0313 the document databases include electronic representation of other documents of interest to the customer such as prior art references. These documents are stored in a prior art database] [0315] It should be understood that the document databases of Figure 6 are shown for purposes of illustration and not limitation. The document databases store representations of documents that are of interest to the customer [0373-0379] [1069];

associating in a case table, the reference link with an identifier [0388-0394] Figures 12B-15 (Figure 12 H (1226) prior art, Document id, prior art id) [0797]; and

a pointer to information ([0603] [0702].

While Rivette discloses searching, storing, retrieving relevant documents to a patent application, and extracting and loading prior art information [0835], Rivette does not disclose accessing an electronic IDS or using the information in the process of generating an information statement in a form suitable for filing with an official patent office, or transmitting the document to the patent office.

However Petruzzi discloses an electronic information disclosure statement and incorporating, with an automated process, at least some of the extracted information from the electronic document into an electronic information statement wherein the at least one electronic document includes information corresponding to a plurality of fields in the electronic information disclosure statement, and wherein incorporating at least some of the extracted information comprises storing the information in the corresponding plurality of fields in the IDS (Figure 2 (Forms 39) col. 2, lines 65-67, col. 5, line 48 thru col. 6, line 7 The Form 1449 for submitting information in the form of patents, publications, etc is provided, operator is prompted for references, a brief description of each reference and the relevance. After information is inputted, the computer automatically generates a first draft).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the searching and storage of relevant documents disclosed in Rivette the electronic IDS taught in Petruzzi so that once the relevant documents are identified, the applicant is able to comply with the rules and regulations of the patent office by submitting the relevant prior art as required in the form appropriate for filing

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with the Patent and Trademark Office with the assistance of a guided wizard that prompts the user.

Rivette nor Petruzzi disclose transmitting the electronic information statement to the official patent office.

However, Tran discloses providing for the transmission of the statement to an official patent office (Figure 2C (226) File application, [0007] generation and filing of a complete patent application [0017] techniques support electronic patent filing [0049]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the search and retrieval disclosed in Rivette and the electronic IDS disclosed in Petruzzi the transmission taught in Tran so as to provide support for electronic patent filing that substitutes an electronic form of an IDS for a paper copy which facilitates and enhance the procurement of IP assets at Internet speed which can minimize cost and speed up the application process.

**NOTE:** Claim Construction - "Automatically" - Without human interaction such that a human does not have to intercede and alter the flow. Process may be automatic even though human initiates or may interrupt *Collegenet, Inc. v Applyyourself, Inc.* (CAFC, 04-1202,1222-1251, 8/2/2005)

Referring to Claim 3:

Rivette discloses storing a reference link to the electronic document in a reference table and storing an identifier corresponding to a patent case in a case

number table and associating the reference link in the reference table to the identifier in the case number table [0373-0379] [0388-0394] Figures 12B-15 (Figure 12 H (1226) prior art, Document id, prior art id [01217-1235] [1226-1228 selected patent may be linked to references to other documents).

Referring to Claims 7-8, 19-21:

Rivette discloses providing a prompt comprising an electronic button [0407] [1166] [1176] [1175-1177] [1222] [1247-1248].

Referring to Claim 9:

Rivette discloses wherein the first data source is coupled to the remote server system over a computer network (Figures 3-5).

Referring to Claim 10:

Tran discloses providing access to the electronic document to multiple users over a network ([Figure 1 and [0043] one or more client workstations are connected).

Referring to Claim 11:

Tran discloses electronically transmitting the electronic IDS to a patent office (Figure 2C file application, [0007] generation and filing of a complete patent application [0017] techniques support electronic patent filing).

Referring to Claim 12:

Tran discloses receiving a signal indicating that a patent application corresponding to the electronic IDS is being electronically transmitted to a patent office and electronically transmitting the IDS and application to the Patent Office (Figure 2C (220) and (226) [0017] [0044] [0048] [0049]).



Referring to Claims 13-15 and 20-23:

Rivette discloses wherein the electronic document is an electronic version of a US patent, a foreign patent or a publication ([0321-0322]).

### ***Double Patenting***

4. Claims 1, 3, 7-16, 18-23, 25-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-17, 19-23, 32-49, 51-53, 58, 60-65 of copending Application No. 09/733,616. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims in both application are directed to a method, system and program for providing an interface to allow a user to search or review electronic documents, receiving a signal from the user indication that a document has been identified, saving the document in a database, and incorporating at least some of the information into an information disclosure statement and filing the statement electronically.

Application 09/733,616 includes dependent claims which address access codes to retrieve the information from the databases. However, the Examiner asserts that access codes to retrieve information is old and well known and would have been obvious to one of ordinary skill in the art at the time of the invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

5. Applicant's arguments filed July 30, 2007 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

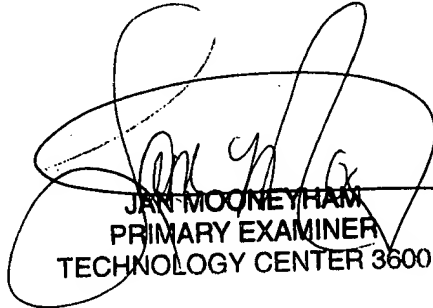
Rivette in combination with Petruzzi discloses storing IDS information via an automated process at a server system database, and Rivette in combination with Petruzzi discloses extracting the information from the electronic document and storing the IDS information in a format specified by the official patent office.

The applicant's claim language reads "adding the IDS information to the electronic IDS via an automated process at the server system". The language "an automated process at the server system" can reasonably be read to include a user adding the IDS information via a computer system. Furthermore, Petruzzi discloses that after the information is inputted, the computer automatically generates a first draft information disclosure statement by adding appropriate phrases and formatting.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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